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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/065,286

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Christian A. Beck

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03/01/2006

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EXAMINER

ROGERS, DAVID A

ART UNIT

PAPER NUMBER

2856

DATE MAILED: 03/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/065,286	Applicant(s) BECK, CHRISTIAN A.	
	Examiner David A. Rogers	Art Unit 2856	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Appeal***

1. In view of the appeal brief filed on 23 November 2005, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below. To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

***Specification***

2. The disclosure is objected to because of the following informality. In paragraph 0039, on page 8, the applicant refers to the company "Alexter Technologies, LLC". The correct name for this company is --Alexeter Technologies, LLC--. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2856

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 6-10, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over to United States Patent 6,524,846 to Robinson, Jr. in view of United States Patent Application Publication 2004/0046009 to Weisenberg *et al.*, "Guardian Reader System Frequently Asked Questions" to Alexeter, and United States Patent 5,179,281 to Tawil *et al.*

Robinson, Jr. teaches an envelope (reference item 20) comprising a hazardous material indicator (reference item 10). The hazardous material indicator is mounted on a transparent holder (reference item 17), as seen in figure 1. The transparent holder with the hazardous material indicator is mounted on a hole (window) (reference item 13) on the front side the envelope so that it is visible to the human eye. Furthermore, the hazardous material indicator is provided as a coated substrate (reference item 12) having a pH between 2 and 5. The hazardous material indicator is capable of detecting the gaseous amines released by *Bacillus anthracis* (anthrax) and will change color accordingly. The list of preferred coatings includes Phenol Red which is known in the art to turn red in color. Robinson, Jr. teaches that:

"Other envelopes 20 in accordance with the principles relating to the present invention must be sorted manually and it is unimportant as to where the bacterial biological agent/toxin indicator 10 is located except that it must be in communication with the interior 19 of the envelope 20 and visible from an exterior of the same."

Finally, Robinson, Jr. also teaches that the hazardous material indicator will comprise an electronic fingerprint (reference item 16) representing an electronic code that is machine readable.

Robinson, Jr. does not expressly teach the use of an envelope with a plurality of holes as seen on line 3 of the applicant's claim 1. It is, however, known in envelope manufacturing to provide the envelopes with a plurality of holes. One can see exemplary examples of these types of envelopes in Weisenberg *et al.* (see figures 5a-10). Furthermore, the Government, among others, has employed reusable inter-office/inter-facility envelopes for decades. These envelopes also comprise a plurality of holes located on the front side and back side.

Robinson, Jr. does not expressly teach a hazardous material indicator including an identifier associated with time data as seen on line 6 of the applicant's claim 1. First, the applicant admits that the test strips utilized in their invention are known in the art. Specifically, the applicant utilizes the Bio-Threat Alert test strips from Alexeter. See page 8 of the specification. Alexeter teaches that their Bio-Threat Alert test strips have a limited shelf life. It is stated that the shelf life time is about 12 months. One of ordinary skill in the art would also recognize that the useful life of the indicator would be substantially less than 12 months once unsealed.

Tawil *et al.* teaches a hazardous material indicator (reference item 10) comprising a substrate (reference item 11) and an identifier (reference items 25

and 26). The identification numbers of the indicator is associated with date and time data (column 4, lines 25-50; column 12, lines 26-58). The date/time data is useful as it provides an indication of last “annealing” of the indicator.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Robinson, Jr., with the teachings of Weisenberg *et al.*, Alexeter, and Tawil *et al.* to provide a hazardous material test strip with an envelope having a plurality of holes wherein a machine-readable tag is included with the test strip and is associated with time data.

The plurality of holes, as taught by Weisenberg *et al.*, would allow one to easily determine if there are any remaining contents, e.g. letters, papers, coins, small items, that must be removed prior to disposal or reuse of the envelope.

Associating the electronic tag of Robinson, Jr. with time data would allow one to know the time elapsed since the test strip was manufactured in order to know if the test strip has exceeded its shelf life, i.e., is no longer safe to use as a hazardous material detector. Likewise, associating the test strip with time data would allow one to know how long the test strip was opened so that it can be used in a timely manner.

With regard to claim 7 it would have been obvious to mount the hazardous indicator on the back side of the envelope. First, the applicant admits that the locating the insert in an envelope is within the scope of one of ordinary skill. See applicant’s disclosure, §0040 where it is stated:

“The placement of the inserts and the orientation of the envelopes can be determined by one of ordinary skill in the art.”

Furthermore, Robinson, Jr. teaches that the location of the indicator is irrelevant as long as it can be seen. Finally, an indicator placed on the back side space would not cause any interference with existing automated mail processing equipment.

With regard to claim 16 it is noted that line two of the claim reads “the holder substantially fits the envelope.” The holder of Robinson, Jr. does indeed substantially fit the envelope. The holder is not shown as extending beyond the edges of the envelope.

5. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weisenberg *et al.* in view of United States Patent 4,840,919 to Attar, Robinson, Jr., Alexeter, and Tawil *et al.*

Weisenberg *et al.* teaches an envelope comprising a plurality of holes. The holes are provided in the envelope in order to reduce the risk that hazardous materials will be contained therein. Weisenberg *et al.* does not teach the use of a hazardous material indicator as part of the envelope.

Attar teaches a hazardous material indicator as seen in figures 1 and 2. The indicator comprises a base (reference item 12) that operates as a holder, a cover (reference item 14) with an opening (reference item 14a), and a substrate (reference item 22). The substrate is an acid base that can have a pH less than 4.5 capable of undergoing a visible change, i.e. a color change, in the presence of amines. Attar teaches that the color change can be red. See column 4, lines 1-5. The materials used to form the indicator include halo derivatives.

Robinson, Jr. teaches a hazardous material indicator formed as an integral component of an envelope. The indicator's solution can include be composed of halogenated xanthene dyes, e.g., Phloxine B, Rose Bengal or sulphonated azo dyes, e.g. Congo Red. Irrespective of the base materials, Robinson, Jr. teaches that that the hazardous material indicator will have a pH between 2 and 5, and will change color in the presence of amines released by viral agents such as anthrax.

Robinson, Jr. does not expressly teach a hazardous material indicator including an identifier associated with time data as seen on line 6 of the applicant's claim 1. However, the applicant admits that the test strips utilized in their invention are known in the art. Specifically, the applicant utilizes the Bio-Threat Alert test strips from Alexeter. See page 8 of the specification. Furthermore, Alexeter teaches that their Bio-Threat Alert test strips have a limited shelf life. It is stated that the shelf life time is about 12 months. One of ordinary skill in the art would also recognize that the useful life of the indicator would be substantially less than 12 months once unsealed.

Tawil *et al.* teaches a hazardous material indicator (reference item 10) comprising a substrate (reference item 11) and an identifier (reference items 25 and 26). The identification numbers of the indicator is associated with date and time data (column 4, lines 25-50; column 12, lines 26-58). The date/time data is useful as it provides an indication of last "annealing" of the indicator.



It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Weisenberg *et al.* with the teachings of Attar, Robinson, Jr., Alexeter, and Tawil *et al.* to place a hazardous material indicator inside an envelope so that it can move inside the envelope. The hazardous material indicators of Attar and Robinson, Jr. operate on the same principle (detecting the presence of amines and indicating such presence using a color change), and they can be used in the same manner, e.g., both Robinson, Jr. and Attar teach that their respective indicators can be formed as part of a wearable badges.

Furthermore, the device of Attar can be used in any envelope without having to retrofit each envelope to have an integral indicator such as taught by Robinson, Jr. Also, while Weisenberg *et al.* teaches that their holes allow hazardous materials to fall out, one of ordinary skill will quickly recognize that powders will tend to settle in any crevices or otherwise adhere to the surfaces of envelopes. The detector of Attar, when placed in any envelope including those from Weisenberg *et al.*, will help ensure that any residual hazardous materials will be detected, or if the material spills onto other envelopes, the indicator can detect when cross-contamination occurs.

Finally, associating the electronic tag of Robinson, Jr. with time data would allow one to know the time elapsed since the test strip was manufactured in order to know if the test strip has exceeded its shelf life, i.e., is no longer safe to use as a hazardous material detector. Alos, associating the

test strip with time data would allow one to know how long the test strip was opened so that it can be used in a timely manner.

6. Claims 11-15 stand as rejected under 35 USC 103(a) as being obvious over the Robinson, Jr. in view of Weisenberg *et al.*, Attar, and Tawil *et al.*

Robinson, Jr. teaches an envelope with a color changing indicator as noted above. Robinson, Jr. does not teach a warning message.

The addition of a warning label or other instructions to the envelope of Robinson, Jr. to inform any mailpiece handler of the significance of the color of the hazardous indicator would have been an obvious modification. Not everyone would automatically know the significance of the indicator's color, and therefore, whether or not the envelope was exposed to such agents as anthrax. Giving simple instructions, even in the form of a warning label, would help ensure that even the average user would be able to know if they have been or if the envelope was exposed to potentially harmful agents.

Furthermore, in *In re Ngai*, 70 USPQ 2d 1862, the Court of Appeals for the Federal Circuit (CAFC) reviewed a situation analogous to the present application. In *Ngai* a kit was claimed as follows (emphasis added):

19. A kit for normalizing and amplifying an RNA population, said kit comprising instructions describing the method of claim 1 and a premeasured portion of a reagent selected from the group consisting of: oligo dT biotinylated primer, T7 RNA polymerase, annealed biotinylated primers, streptavidin beads, polyadenyl transferase, reverse transcriptase, Rnase H, DNA pol I, buffers and nucleotides.

The CAFC specifically addressed the elements that formed the claimed kit and clearly showed how it was anticipated by the prior art despite the fact that Ngai's claim 1 method was patentable. In referring to *In re Gulack*, 703 F.2d 1381 [217 USPQ 401] (Fed. Cir. 1983), the CAFC stated:

"This case [*Ngai*], however, is dissimilar from *Gulack*. There the printed matter and the circularity of the band were interrelated, so as to produce a new product useful for "educational and recreational mathematical" purposes. Here, addition of a new set of instructions into a known kit does not interrelate with the kit in the same way as the numbers interrelated with the band. In *Gulack*, the printed matter would not achieve its educational purposes without the band, and the band without the printed matter would similarly be unable to produce the desired result. Here, the printed matter in no way depends on the kit, and the kit does not depend on the printed matter. All that the printed matter does is teach a new use for an existing product. As the *Gulack* court pointed out, "[w]here the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability." *Id.* If we were to adopt Ngai's position, anyone could continue patenting a product indefinitely provided that they add a new instruction sheet to the product."

The CAFC found that the claimed kit in *Ngai* was anticipated by the prior art since a kit, e.g., a 10X buffer with instructions, was known in the art and that Ngai's instructions merely taught how to use the kit (the 10X buffer). More specifically, the CAFC stated:

"All that the printed matter does is teach a new use for an existing product."

and

"He [*Ngai*] is not, however, entitled to patent a known product by simply attaching a set of instructions to that product."

In the present application the warning message serves only to instruct.

Paragraph 0048 of the applicant's specification states:

"The hazardous material detection mailpiece 210 can also include a warning label 208 or printed warning, or the like, on the envelope 200. In the embodiment of FIG. 6 the warning states "IMPORTANT CAUTION: HAZARDOUS MATERIAL DETECTION INCLUDED IN ENVELOPE--RED TEST AREA INDICATES CONTAMINATION."

Likewise, paragraph 0052 of the applicant's specification states:

"The mailpiece 210 includes an envelope to contain one or more test strips 204, holes 206 in the envelope and a warning indicator 208. The envelope 200 comprises a front side 200a (shown in FIGS. 4, 5 and 6), a back side 200b and an envelope flap 200c. The envelope 200 contains a hazardous material test strip 204 as is illustrated with dotted lines in FIG. 9. The envelope further comprises holes 206 or perforations for providing an inlet for hazardous material to contact the hazardous material test strip 204. The warning label or printed message 208, or the like, in the embodiment of FIG. 9 states "IMPORTANT CAUTION: HAZARDOUS MATERIAL DETECTION INCLUDED IN ENVELOPE--RED TEST AREA INDICATES CONTAMINATION."

Lastly, the applicant's figures 6 and 8 also clearly show that the warning label merely instructs the user as to the meaning of the color of the hazardous indicator.

The applicant's warning message serves only to instruct. The warning message does not enable the envelope to detect hazardous materials (that is what the indicator is for). Furthermore, the warning message need not be located on the envelope in order to inform a mailpiece handler as to the meaning of any color change. For example, the warning message could easily be a placard in a mail processing facility.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Robinson, Jr. in view of

Weisenberg *et al.*, Attar, and Tawil *et al.* to include a warning message on an envelope in order to inform any mailpiece handler as to the meaning of the indicator's color change.

**Conclusion**

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Rogers whose telephone number is (571) 272-2205. The examiner can normally be reached on Monday - Friday (0730 - 1600).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron E. Williams can be reached on (571) 272-2208.

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The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below.



28 February 2006



HEZRON WILLIAMS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800